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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]LLIVAN	[illegible]

08/556,237

[illegible]

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EXAMINER	
[illegible]	
ART UNIT	**PAPER NUMBER**
[illegible]	2

DATE MAILED: 02/08/96

02/08/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on ________ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~_____ days from~~ the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☑ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ ________.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-6 are pending in the application.

   Of the above, claims ________ are withdrawn from consideration.

2. ☐ Claims ________ have been cancelled.
3. ☐ Claims ________ are allowed.
4. ☑ Claims 1-6 are rejected.
5. ☐ Claims ________ are objected to.
6. ☐ Claims ________ are subject to restriction or election requirement.
7. ☑ This application has been filed with informal drawings ~~under 37 C.F.R. 1.85~~ which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on ________. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on ________. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed ________, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ________ ; filed on ________.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Nesbitt in view of Nakamura. Nesbitt discloses the claimed invention with the exception of the particulars of the materials utilized. However, one of ordinary skill in the art would, in view of Nesbitt's disclosure, recognize that other materials known in the art could have been utilized in the invention so long as the cover comprised a harder inner layer of Shore D hardness of 60 with a softer outer layer. As disclosed by Nakamura the use of hard materials such as that claimed for the inner cover layer is known in the art. It would have been obvious to one of ordinary skill in the art to have utilized such known materials in the manufacture of Nesbitt's ball absent a showing of unexpected results.

Regarding claims 2 and 3, it would have been obvious to one of ordinary skill in the art to have increased the thicknesses of Nesbitt's layers to increase the durability of the ball.

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending application Serial No. 08/542,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because removal of the additionally claimed features with their corresponding loss of function would have been obvious to one of ordinary skill in the art.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG
January 29, 1996

MARK S. GRAHAM
PRIMARY EXAMINER
GROUP 3300